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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/873,480 | 06/04/2001 | Nils Erik Vilhelm Martensson | 200-004346-US (C03) | 5807 |
| 2512 | 7590 | 06/18/2004 | | |
| PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824 | | | EXAMINER VUONG, QUOCHIE B | |
| | | | ART UNIT 2685 | PAPER NUMBER H |
| DATE MAILED: 06/18/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,480

Applicant(s)

VILHELM MARTENSSON ET AL

Examiner

Quochien B Vuong

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/003,785.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/003,785, filed on 01/13/1993.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 06/04/01 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 12-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,349,212.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 7 of U.S. Patent No. 6,349,212 encompasses all the limitations of claims 12-16 of the pending application including: in a communication system comprising a wireless telephone and a base station capable of bidirectional wireless communications with the wireless telephone; a method for placing a telephone call comprising steps of: in response to an input from a user of a wireless telephone, initiating the placement of a telephone call in accordance with signaling information exchanged between the telephone and the base station; and completing the placement of the call after the base station receives audio voice information transmitted from the wireless telephone by arranging the base station to interpret the audio voice information using audio recognition means, and wherein the audio voice information includes an identification of a telephone number to be called; wherein the audio voice is spoken by the user directly into the telephone; the step of initiating is fully completed before the user enters the audio voice information into the telephone; wherein the step of completing comprises the base station using voice recognition in determining the telephone number based upon the audio voice information transmitted from the telephone to the base station; and wherein the audio voice information is transmitted from the telephone to the base station as audio voice sound signals.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke et al. (US 4,677,656) in view of Gerson et al. (US 4,870,686) and Reed et al. (US 5,371,901).

Regarding claim 12, Burke et al. disclose in a communication system comprising a wireless telephone (18, 19) and a base station (24, 28) capable of bidirectional wireless communications with the wireless telephone; a method for placing a telephone call comprising steps of: in response to an input from a user of a wireless telephone, initiating the placement of a telephone call in accordance with signaling information exchanged between the telephone and the base station (dial command, col. 10, lines 16-19); and completing the placement of the call after the base station receives audio information (DTMF tones, which are dual tone audio tones, col. 10, lines 20-60) which denote the telephone number to be called from the wireless telephone. Burke fails to disclose that the information is voice audio information; and the audio recognition means for the base station to interpret the audio voice information. However, Gerson et al. teaches in an analogous art, the use of voice audio information (speech denoting a telephone number) which is input to a mobile telephone system in order to dial a particular destination (col. 2, lines 49-52). Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to include voice

audio information for dialing, as taught by Gerson et al. to the method of Burke et al. in order to provide a hands-free communication environment. The combination of Burke et al. and Gerson et al. fails to teach the audio recognition means at the base station to interpret the audio voice information. However, Reed et al. teach in an analogous art, a base station containing voice recognition circuitry for executing the voice command (col. 2, lines 22- 23; and figure 3). Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to adapt the teaching of Reed et al. to include the voice recognition circuitry to the base station of Burke et al. and Gerson et al. so that the base station can recognize the telephone number to be dial and execute the voice command in order to reduce the amount of circuitry required within the wireless unit in the hands-free communication environment.

Regarding claim 13, the combination of Burke et al., Gerson et al., and Reed et al. teach the method of claim 12 above, Gerson et al. further disclose the audio voice information is spoken by the user into a microphone (152, directly into the telephone).

Regarding claims 14-16, the combination of Burke et al., Gerson et al., and Reed et al. teach the method of claim 12 above, Reed et al. further teach the initiating step is fully completed before the voice information is inputted (voice recognition of certain commands within conversation, col. 2, lines 22-23) as well as the forwarding of the voice information (commands) to a base station, which contains voice recognition circuitry for executing the voice command (figure 3).

Response to Arguments

7. Applicant's arguments with respect to claim 12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Paterson et al. (US 5,557,653) disclose a headset for hands-free wireless telephone.

Griffith et al. (US 6,128,514) disclose portable radio telephone for automatically dialing a central voice-activated dialing system.

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington, VA 22202. Sixth Floor (Receptionist).

Any inquiry concerning this communication from the examiner should be directed to Quochien B. Vuong whose telephone number is (703) 306-4530. The examiner can normally be reached on Monday through Friday from 9:30 a.m. to 6:00 p.m. EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached on (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377.



QUOCHIE B. VUONG
PRIMARY EXAMINER

Quochien B. Vuong

June 04, 2004.